

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-26 are pending in the application, with claims 1, 13, 21, and 23 being independent claims. Claims 1 and 9-11, 13, and 21-23 are sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Examiner Interview

Applicants wish to thank Examiners Anyikire and Banks-Harold for extending them the courtesy of an interview held on January 28, 2008. The substance of the interview is provided in the Interview Summary of that date.

Rejections under 35 U.S.C. § 102

Paragraph 2 of the Office Action rejects claims 1, 8-10, 13, and 15-16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,371,532 to Gelman, *et al.*, (“Gelman”). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

As understood by Applicants, the COs disclosed by Gelman appear to store requested information programs only temporarily. (*See, e.g.*, Gelman at col. 12, ll. 19-22.)

Thus, as described in Gelman, as the program is played out to the subscriber, the buffer in which the segments are stored is *completely depleted*. (*Id.*) Further, the COs in which the information is temporarily stored do not appear to be owned by the subscriber, but rather owned by the service provider.

Contrary to the architecture and operation disclosed in Gelman, claim 1 recites “a storage device owned by the subscriber to receive the music and store the music to allow playback by the subscriber a plurality of times without depletion of the stored music.” Applicants respectfully submit that Gelman discloses no such subscriber storage device. First, because Gelman’s CO completely depletes the stored music when it is streamed to the subscriber CPE, it does not “allow playback by the subscriber a plurality of times without depletion of the stored music.” Second, because Gelman’s COs appear to be located at the service provider’s site, they do not appear to be owned by the subscriber. Thus, Applicants respectfully submit Gelman neither teaches nor suggests that the disclosed CPE stores the information program. Because Gelman does not disclose the recited “subscriber storage device,” Applicants respectfully assert that Gelman does not teach each and every element recited in claim 1 or its dependent claims 8-10. Consequently, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 1, and its dependent claims 8-10, under 35 U.S.C. § 102(b) as being anticipated by Gelman set forth in paragraph 2 of the Office Action.

Claim 13 recites “transmitting a music file comprising the music desired to be stored for storage in subscriber equipment that is owned by the subscriber in response to the

request” and “storing the music file in the subscriber equipment such that the stored music can be played back by the subscriber a plurality of times without depleting the stored music.” As described above with respect to claim 1, Applicants respectfully submit that Gelman neither teaches or suggests “transmitting a music file comprising the music desired to be stored for storage in subscriber equipment that is owned by the subscriber in response to the request” as recited in claim 13. Further, Applicant respectfully submits that Gelman does not disclose “storing the music file in the subscriber equipment such that the stored music can be played back by the subscriber a plurality of times without depleting the stored music.” Indeed, as pointed out above with respect to claim 1, Applicants respectfully assert Gelman teaches away from playing back information without depleting the stored file.

Thus, Applicants respectfully assert that Gelman does not disclose each and every element recited in claim 13. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 13 and its dependent claims 15-16 under 35 U.S.C. § 102(b) as being anticipated by Gelman set forth in paragraph 2 of the Office Action.

Rejections under 35 U.S.C. § 103

Paragraph 4 of the Office Action rejects claims 2, 3, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Gelman. For the reasons below, Applicant respectfully requests the Examiner reconsider and withdraw this rejection.

While acknowledging that Gelman does not teach the particular features recited in claims 2, 3, and 14, the Examiner takes official notice that such features would be obvious to

those having ordinary skill in the art. Without addressing the propriety of the rejection, Applicants respectfully assert that claims 2, 3, and 14 are patentable over Gelman because, as described above, Gelman does not teach or suggest each of the elements of the claims 1 and 13, from which claims 2, 3, and 14 respectively depend directly or indirectly.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2, 3, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Gelman set forth in paragraph 4 of the Office Action.

Paragraph 5 rejects claim 21 under 35 U.S.C § 102(b) as being anticipated by U.S. Patent No. 6,959,419 to Taniwaki (“Taniwaki”). Applicants respectfully submit the rejection was intended to be a rejection under 35 U.S.C § 103(a) due to its placement under the heading “Claim Rejections – 35 USC § 103” and the conclusion to the rejection, “Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention....” Applicants respond as if the rejection were under 35 U.S.C. § 103(a). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claim 21 recites, “a database comprising data corresponding to one or more movies, songs in the movies and movie soundtracks that provides a computer data file that represents the identified movie, song, or movie soundtrack to the computer.” Applicants respectfully submit that nowhere does Tanikawa teach or suggest this feature of the claimed invention or the combination of features recited in claim 21. Accordingly, Applicant respectfully

requests the Examiner reconsider and withdraw the rejection of claim 21 under 35. U.S.C. § 103(a) as obvious over Tanikawa set forth in paragraph 5 of the office action.

Paragraph 5 of the Office Action further appears to reject claims 22. It is unclear from the Office Action the basis for the rejection. However, for the reasons provided with respect to claim 21 above, Applicants respond as if the rejection of claim 22 was made under 35 U.S.C. § 103(a). Claim 22 each depends from claim 21. Applicants respectfully submit that, as described above, claim 21 is patentable over Tanikawa. Accordingly, Applicants respectfully submit that claim 22 is also patentable over Tanikawa. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 22 under 35. U.S.C. § 103(a) as obvious over Tanikawa set forth in paragraph 5 of the office action.

Paragraph 5 of the Office Action further appears to reject claim 23. It is unclear from the Office Action the basis for the rejection. However, for the reasons provided with respect to claim 21 above, Applicants respond as if the rejection of claim 23 was made under 35 U.S.C. § 103(a). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claim 23 recites “a database comprising computer data files representing one or more movies, songs in the movies and movie soundtracks that is queried by the second computer and provides the computer data file representing the identified movie, song, or movie soundtrack to the second computer in response to the query,” “a destination computer to receive the computer data file from the computer,” and “a storage device owned by the subscriber on which to store the received computer data file from the database.” Applicants

respectfully submit Tanikawa does not teach or suggest these features recited in claim 23.

Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 23 under 35 U.S.C. § 103(a) as obvious over Tanikawa set forth in paragraph 5 of the office action.

Paragraph 6 of the Office Action rejects claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Gelman in view of U.S. Patent No. 7,014,484 to Hagiwara (“Hagiwara”) and further in view of U.S. Patent No. 7,233,658 to Koser *et al.* (“Koser”). For the at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw this rejection.

Claims 4-6 depend directly or indirectly from claim 1. As described above, Gelman does not disclose or suggest each and every element of claim 1. Applicants respectfully submit that neither Hagiwara nor Koser teaches or suggests these deficiencies. Consequently, Applicants respectfully assert that neither Gelman nor Hagiwara nor Koser, whether taken alone or in combination, teaches or suggests the combination of features recited in claims 4-6. Accordingly, Applicants respectfully assert that the combination of Gelman with Hagiwara and Koser, to the extent such combination can be made, does not render claims 4-6 obvious. Consequently, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Gelman in view of Hagiwara, and further in view of Koser.

Paragraph 7 of the Office Action rejects claims 7 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Gelman in view of U.S. Publication No. 2007/0177586 to Eyal

("Eyal"). For the following reasons, Applicants respectfully request the Examiner reconsider and withdraw this rejection.

Claims 7 and 17 depend from claims 1 and 13 respectively. As described above, Gelman does not disclose or suggest each and every element of claim 1 or claim 13. Applicants believe that Eyal does not teach or suggest these deficiencies. Consequently, Applicants respectfully assert that neither Gelman nor Eyal, whether taken alone or in combination, teaches or suggests the combination of features recited in claims 7 or 17. Accordingly, Applicants respectfully assert that the combination of Gelman with Eyal, to the extent such combination can be made, does not render claims 7 and 17 obvious. Consequently, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 7 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Gelman in view of Eyal.

Paragraph 8 of the Office Action rejects claims 11-12 under 35 U.S.C. § 103(a) as being unpatentable over Gelman in view of U.S. Publication No. 2001/0000808 to Lesley ("Lesley"). For the following reasons, Applicants respectfully request the Examiner reconsider and withdraw this rejection.

Claims 11-12 depend indirectly from claim 1. As described above, Gelman does not disclose or suggest each and every element of claim 1. Applicants believe that Lesley does not teach or suggest these deficiencies. Consequently, Applicants respectfully assert that neither Gelman nor Lesley, whether taken alone or in combination, teaches or suggests the combination of features recited in claims 11-12. Accordingly, Applicants respectfully assert

that the combination of Gelman with Lesley, to the extent such combination can be made, does not render claims 11-12 obvious. Consequently, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 11-12 under 35 U.S.C. § 103(a) as being unpatentable over Gelman in view of Lesley.

Paragraph 9 of the Office Action rejects claims 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Gelman in view of U.S. Publication No. 2005/0031314 to Galdos (“Galdos”). For the following reasons, Applicants respectfully request the Examiner reconsider and withdraw this rejection.

Galdos appears directed to a system for disseminating information without using a network server or satellite-based communication system. Rather, Galdos stores the information on a video disc. The disc is then disseminated to targeted recipients. In direct contrast, Gelman appears directed to a network-server based system. Thus, Applicants respectfully submit that Galdos teaches away from the disclosure in Gelman. As a result, Applicants respectfully assert it is improper to combine Gelman with Galdos as the basis of an obviousness rejection. Consequently, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Gelman in view of Galdos.

Paragraph 10 of the Office Action rejects claims 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Tanikawa in view of U.S. Patent No. 6,959,419 to Stern (“Stern”). For the following reasons, Applicants respectfully request the Examiner reconsider and withdraw this rejection.

Claims 24-26 depend directly or indirectly from claim 23. As described above, Tanikawa does not disclose or suggest each and every element of claim 23. Applicants believe that Stern does not teach or suggest these deficiencies. Consequently, Applicants respectfully assert that neither Tanikawa nor Stern, whether taken alone or in combination, teaches or suggests the combination of features recited in claims 24-26. Accordingly, Applicants respectfully assert that the combination of Tanikawa with Stern, to the extent such combination can be made, does not render claims 24-26 obvious. Consequently, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Tanikawa in view of Stern.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Amdt. dated April 7, 2008
Reply to Office Action of October 9, 2007

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Fitzgerald, *et al.*
Appl. No. 10/713,143

Prompt and favorable consideration of this Amendment and Reply is respectfully
requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David C. Isaacson", written in a cursive style.

David C. Isaacson
Registration No. 38,500

Date: April 7, 2008